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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,219	04/09/2001	Jacob Leidner	209391	9737

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,219

Applicant(s)

LEIDNER ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-19,22-41 and 69-91 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4-19,22-41 and 69-91 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

DETAILED ACTION

Statutory Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 11-19 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 9-16 of prior U.S. Patent No. 6,271,286. This is a double patenting rejection.

Present claims 11-19 and claims 1 and 9-16 of U.S. 6,271,286 claim the same invention given that they both disclose an erasable colored pencil lead which is substantially free of low melting waxes or waxy materials having a melting or softening point of about 90 °C or less wherein the erasable colored pencil lead comprises colorant, one or more binder, fibrillated or fibrillatable material, filler, antioxidant, and lubricant which is a non-particulate lubricant which

forms a separate domain from the binder wherein the lubricant is a polar material which is an ethoxylated material such as polyethylene glycol.

Non-Statutory Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 4-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,271,286. Although

the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

U.S. 6,271,286 discloses an erasable colored pencil lead identical to that presently claimed with one exception. The patented claims disclose that the erasable colored pencil lead comprises lubricant that is a non-particulate lubricant which forms a separate domain from the binder wherein the lubricant is a polar material which is an ethoxylated material such as polyethylene glycol while the present claims are silent with respect to such lubricant.

However, in light of the open language of the present claims, i.e. "comprising", it is clear that the use of additional ingredients, including lubricant as disclosed in U.S. 6,271,286, are clearly not excluded from the scope of the present claims.

As evidence to support this position, applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to page 12, line 29-page 14, line 21 of the present specification which discloses that the erasable colored pencil lead of the present claims can in fact contain lubricant identical to that disclosed in U.S. 6,271,286 in order to improve the laydown property of the lead and improve erasability.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to arrive at the present invention from U.S. 6,271,286.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the present application, the abstract is more than 150 words.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 4-19, 34, and 85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 34, and 85 each recite that the erasable colored pencil lead is substantially free of "low melting waxes or waxy materials having a melting point or softening point of about 90 °C or below". The scope of the claims is confusing because it is not clear what the difference is between low melting waxes and waxy materials having a melting or softening point of about 90 °C or less. In other words, the recitation of low melting waxes clearly encompasses waxy materials having a melting or softening point of about 90⁰ C or less, and vice versa. Clarification is requested.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 22, 34-35, 40-41, 73, 85, and 90-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshiba et al. (U.S. 5,595,589).

Hoshiba et al. disclose method of using an erasable colored pencil lead composition which is used to draw lines. Although there is no explicit disclosure of the type of substrate on which the pencil lines are drawn it therefore would have been obvious to one of ordinary skill in

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the art to utilize substrate conventionally used with pencil leads, i.e. paper. Further, it is noted that given that Hoshiba et al. disclose that the composition contain oil and fats "and/or" waxes, it is clear that the use of wax is not required (col.1, lines 8-10, col.4, lines 4-7 and 11-18, col.6, lines 36-41, col.7, lines 16-22, and col.8, lines 28-36).

Although there is no explicit disclosure that the erasable colored pencil lead of Hoshiba et al. forms a cohesive layer, given that Hoshiba et al. disclose that the pencil lead is erasable, it is clear that the pencil lead must inherently form a cohesive layer.

In light of the above, it is clear that Hoshiba et al. anticipates the present claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 22-24, 33, 35-41, 69-75, 84, 86, and 90-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02036281 in view of Koyama (U. S. 5,716,434).

JP 02036281 discloses method for using an erasable colored pencil lead by applying the lead to paper in order to create a mark wherein the erasable colored pencil lead comprises polyethylene binder, fibrillatable ethylene-vinyl acetate copolymer, lubricant, filler, and colorant and wherein the mark is erasable by an eraser (claim 1, paragraph bridging pages 1-2, page 3, first full paragraph, page 4, lines 2-6, and page 7, lines 4-6).

The only difference between JP 02036281 and the present claimed invention is the requirement in the claims of antioxidant.

Koyama, which is drawn to pencil leads, discloses the use of antioxidant in order to improve the preservability of the pencil lead (col.3, lines 25-26).

Although JP 02036281 and Koyama are silent with respect to erasability, smear rate, and smudge rate of the erasable colored pencil lead composition, given that JP 02036281 in view of Koyama discloses composition comprising fibrillatable material and lubricant as presently

claimed which both enhance the erasability of the composition, it is clear that the composition would intrinsically possess erasability, smear rate, and smudge rate as presently claimed.

Further, there is no explicit disclosure that the erasable colored pencil lead produces a cohesive layer. However, given that JP 02036281 discloses that the written mark has sufficient strength against damage, abrasion resistance, and improved erasability and further given that JP 02036281 in view of Koyama discloses composition as presently claimed, it is clear that the erasable colored lead composition of JP 02036281 intrinsically forms a cohesive layer as presently claimed.

In light of the motivation for using antioxidant disclosed by Koyama as described above, it therefore would have been obvious to one of ordinary skill in the art to use such antioxidant in the erasable colored pencil lead of JP 02036281 in order to produce a pencil with improved preservability, and thereby arrive at the claimed invention.

13. Claims 25-32, 76-83, and 87-89 rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02036281 in view of Koyama as applied to claims 22-24, 33, 35-41, 69-75, 84, 86, and 90-91 above, and further in view of either JP 03153778 or Grossman et al. (U.S. 4,371,632).

The difference between JP 02036281 in view of Koyama and the present claimed invention is the requirement in the claims of specific type of lubricant.

JP 03153778, which is drawn to colored pencils, discloses the use of polyethylene glycol lubricant in order to obtain a pencil with excellent writability and durability (page 2, last paragraph and page 4, second full paragraph).

Alternatively, Grossman et al., which is drawn to pencil leads, discloses the use of lubricants such as polyethylene glycol in order to enhance writing smoothness (col.5, lines 30-33 and col.6, lines 28-29 and 44-45).

Although neither of the above references explicitly discloses that the lubricant forms a separate domain from the binder, given that the reference lubricant is identical to that presently claimed, it is natural to infer that the reference lubricant will also function so as to form a separate domain as presently claimed.

In light of the motivation for using polyethylene glycol lubricant disclosed by either JP 03153778 or Grossman et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such lubricant in the erasable colored pencil lead of JP 02036281 in order to produce a pencil lead that has excellent writability and durability, or alternatively, writing smoothness, and thereby arrive at the claimed invention.

14. Claims 23-33, 36-39, 74-84, and 86-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshiba et al. (U.S. 5,595,589) in view of JP 55025368, JP 02036281, Koyama (U.S. 5,716,434), and either JP 03153778 or Grossman et al. (U.S. 4, 371,632).

The disclosure with respect to Hoshiba et al. in paragraph 9 above is incorporated here by reference. Additionally, it is noted that Hoshiba et al. disclose that the erasable colored pencil lead comprises pigment, filler, binder, and colorant.

The difference between Hoshiba et al. and the present claimed invention is the requirement in the claims of (a) antioxidant, (b) fibrillatable copolymer, (c) polyethylene glycol lubricant, and (d) specific type of binder.

With respect to difference (a), Koyama, which is drawn to pencil leads, discloses the use of antioxidant in order to improve the preservability of the pencil lead (col.3, lines 25-26).

In light of the motivation for using antioxidant disclosed by Koyama as described above, it therefore would have been obvious to one of ordinary skill in the art to use such antioxidant in the erasable colored pencil lead of Hoshiba et al. in order to produce a pencil with improved preservability, and thereby arrive at the claimed invention.

With respect to difference (b), JP 02036281, which is drawn to erasable colored pencil leads, discloses the use of fibrillatable material such as ethylene vinyl-acetate. The motivation for using the ethylene vinyl-acetate is to produce a pencil lead with good writing touch, erasability, and strength (page 3).

In light of the motivation for using ethylene vinyl-acetate disclosed by JP 02036281 as described above, it therefore would have been obvious to one of ordinary skill in the art to use ethylene vinyl-acetate in the pencil lead of Hoshiba et al. in order to produce a pencil that has good writing touch, erasability, and strength, and thereby arrive at the claimed invention.

With respect to difference (c), JP 03153778, which is drawn to colored pencils, discloses the use of a polyethylene glycol lubricant in order to obtain a pencil with excellent writability and durability (page 2, last paragraph and page 4, second full paragraph). Alternatively, Grossman et al., which is drawn to pencil leads, discloses the use of lubricants such as polyethylene glycol in order enhance writing smoothness (col.5, lines 30-33 and col.6, lines 28-29 and 44-45).

Although neither of the above references explicitly discloses that the lubricant forms a separate domain from the binder, given that the reference lubricant is identical to that presently

claimed, it is natural to infer that the reference lubricant will also function so as to form a separate domain as presently claimed.

In light of the motivation for using polyethylene glycol lubricant disclosed by either JP 03153778 or Grossman et al., it therefore would have been obvious to one of ordinary skill in the art to use this lubricant in the pencil lead composition of Hoshiba et al. in order to produce a pencil lead that has excellent writability and durability, or alternatively, writing smoothness, and thereby arrive at the claimed invention.

With respect to difference (d), JP 55025368, which is drawn to pencils, discloses the use of thermoplastic polyolefin binders such as polyethylene. The motivation for using these types of binder is to produce pencil leads which high strength and good writing quality (abstract, page 10, line 3).

In light of the motivation for using specific types of thermoplastic binder described by JP 55025368, it therefore would have been obvious to one of ordinary skill in the art to use this binders in the colored pencil lead composition of Hoshiba et al. in order to produce pencils which have high strength and good writing quality, and thereby arrive at the claimed invention.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the

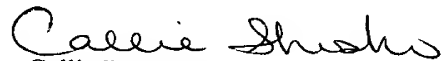
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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Callie E. Shosho
Examiner
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CS
July 1, 2002